



Atty. Docket: 15-SV-5359

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Application of:

Henry J. Hummel, Jr. et al. : Group Art Unit: 2614

Serial No.: 09/477,042 : Examiner: Manning, J.

Filed: December 31, 1999

Title: MEDICAL DIAGNOSTIC SYSTEM WITH
ON-LINE REAL-TIME VIDEO TRAINING

Hon. Commissioner for Patents
Alexandria, VA 22313

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In accordance with the OG Notice of July 12, 2005, the Applicant hereby requests review of the Final Rejection mailed on September 11, 2006 in the above-referenced application. A Notice of Appeal is being filed concurrently herewith.

In the Final Rejection, claims 29-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,449,001 to Levy et al. in view of U.S. Patent No. 5,791,907 to Ramshaw et al. and further in view of U.S. Patent No. 6,477,708 to Sawa. Applicant respectfully submits that this rejection is erroneous for the following reasons.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings; there must be a reasonable expectation of success; and lastly, the combined prior art references must teach or suggest all the claim limitations. It is well settled that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03 further states: "When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the

claims must be considered and given weight, ...". This last criterion has not been met in the Final Rejection.

Each of Applicants' independent claims 29, 30 and 33 contains the limitation that each of the training videos shows one or more of the following:

how to operate a medical diagnostic imaging system of said respective imaging modality, how to perform an examination of a particular exam type on a patient using a medical diagnostic imaging system of said respective imaging modality or how to make a diagnosis during an examination of said particular exam type performed using a medical diagnostic imaging system of said respective imaging modality

Ramshaw is silent concerning videos for training in how to operate a medical diagnostic imaging system, how to perform an examination using such equipment, or how to make a diagnosis during such an examination. Nor do Levy or Sawa disclose these limitations.

In the Final Rejection, the Examiner sought to rebut the foregoing point by asserting:

Ramshaw discloses a training video "how to perform an examination of a particular exam type on a patient using a medical diagnostic imaging system of said respective imaging modality" (See Col. 3 Lines 6-8; Also see Col 3, Line 9 - Col 4, Line 12).

The quoted language, however, is taken from Applicants' independent claims 29, 30 and 33 verbatim, not from Ramshaw. Applicants submit it is completely erroneous to attribute to a cited prior art reference the teaching of a feature that appears nowhere in that reference.

If one examines the Ramshaw patent at column 3, lines 6-8 (cited by the Examiner), one finds the sentence: "The video window displays a prerecorded video segment illustrating a laparoscopic surgical procedure." There is no mention of

training how to perform an examination using a medical diagnostic imaging system. Further details of the Ramshaw system can be found at col. 8, lines 47-51, which refers to various options available on the main menu, including an "Observe Surgery" option, an "Instruments" option and a "Perform Surgery" option. The "Observe Surgery" option allows a user to observe a video demonstration of a particular surgical procedure. [Ramshaw, col. 8, ll. 55-57.] The "Instruments" option provides information about various medical instruments for use in medical procedures. [Ramshaw, col. 8, ll. 65-67.] As seen in Figure 5B of Ramshaw, these instruments (e.g., a stapler, a scalpel, etc.) are not medical diagnostic imaging systems. The "Perform Surgery" option is an interactive module that takes a user through an entire laparoscopic surgical procedure, displaying video of the procedure and prompting the user with questions throughout. [Ramshaw, col. 9, ll. 1-4.] Thus, the viewable options in the Ramshaw system do not include a training video for performing an examination using a medical diagnostic imaging system.

Furthermore, each of claims 29, 30 and 33 recites that, in substance, that both the training video and a diagnostic image of a portion of the anatomy of a patient acquired during an examination are viewed on the same display monitor. This limitation is also absent from each of the Levy, Ramshaw and Sawa references. Ramshaw and Sawa say nothing about imaging of a patient's anatomy for the purpose of diagnosis. To the extent that Levy mentions imaging equipment [see, e.g., col. 2, line 13], diagnostic imaging would be performed on that imaging equipment, not on the portable computer that is connected to

such imaging equipment for teleconferencing purposes. In other words, to the extent that Levy teaches the use of a training video, such video is viewed on the portable computer, whereas the diagnostic image would be viewed on the imaging equipment, i.e., different display monitors would be used.

Also, no motivation for combining the teachings of Levy and Ramshaw can be found in either reference. The Levy patent discloses a teleconferencing system in which the video communications between two locations are bidirectional. The video communications are between the host site and a portable computer at the remote site. In the rejection, the Examiner treats the portable computer as being part of a medical diagnostic imaging system. The crux of Levy's invention is the provision of a portable computer that can be used to provide diagnostic services for servicing any medical apparatus at any remote site. As stated in column 3, lines 10-13: "Preferably, the remote site assembly is portable to enable setup of the assembly in proximity to the device or process that is the subject of the conferencing session." More specifically, Levy discloses that the laptop or notebook computer can be moved from one medical apparatus to another at the same remote site, and can be carried to different remote sites. Levy only discloses that the telecommunication link between computers at the host and remote sites is used "to provide diagnostic services for servicing various research devices, medical equipment and related processes" [see Levy, col. 1, lines 21, 22]. Examples of areas in which the Levy system can be used include:

diagnosing instrument malfunctions, determining misalignment and movement impairments for robotics applications, monitoring

fluidic action in medical applications, diagnosing pressure or vacuum malfunctions and mechanical impairments, diagnosing and adjusting electronic circuitry, and diagnosing technical malfunctions of chemical reactions and dilution ratios

[see Levy, col. 1, lines 57-64].

In contrast to the Levy system, which is intended for use in diagnosing equipment problems, Ramshaw teaches the provision of videos for training in surgical procedures. The performance of surgery presumes that the operating equipment is not malfunctioning. Accordingly, one can find no motivation or suggestion for the concept of making training videos for surgical procedures available on a portable computer intended for use in troubleshooting and diagnosing equipment malfunctions.

Accordingly, Applicants submit that a *prima facie* case for obviousness has not been made and the Final Rejection of claims 29-33 based on Levy, Ramshaw and Sawa should be overturned.

Respectfully submitted,


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CERTIFICATE OF MAILING

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December 11, 2006
Date


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